Remarks

Applicants thank the Examiner for his careful consideration of the application. Claims 1, 3 – 6, 8 and 11 – 14 are pending in the application.

Claim Rejections – 35 USC § 103

The Examiner rejected claims 1, 3 – 6, 8 and 11 – 14 under 35 USC § 103(a) as being unpatentable over Barker (US Patent No. 6,646,765) ("Barker") in view of Yakata (JP Publication No. 10275206) ("Yakata"). These rejections are respectfully traversed.

Claim 1

In claim 1, Applicants recite a method for making written documents available to the visually impaired. The method includes generating a cover sheet including machine readable information, and tactilely readable information, wherein the tactilely readable information includes information regarding one or more user selectable parameters. The method also includes tactilely reading the cover sheet, selecting at least one of the one or more user-selectable parameters, and scanning a document using the cover sheet.

Claim 1 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. In order to sustain an obviousness rejection under 35 U.S.C. 103(a), the Examiner must show that a combination of the cited references teach or suggest all the limitations of the claim being rejected. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner has failed to show that the combination of references teaches or suggests all the limitations of claim 1. The Examiner has not established that Barker discloses reading a cover sheet including user selectable parameters and tactilely readable descriptions thereof, or selecting at least one of the user-selectable parameters based upon its associated tactilely readable description. The Examiner has not pointed to a portion of Yakata that provides this limitation either. The passage from Yakata cited by the Examiner appears to disclose a label with tactilely readable parameters, but the Examiner has not shown where either reference

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discloses user selectable parameters or the ability to select such a parameter based upon a tactilely readable description. Based upon the disclosure in Yakata, combining the disclosure of these two patents would not appear to anticipate all the limitations of Applicants' claimed invention. Therefore, the Examiner has failed to show that the combination of patents discloses all the elements of claim 1. Because the Examiner has failed to prove that claim 1 is obvious in view of the combination of Barker and Yakata, claim 1 should be allowed.

Claims 3 – 6 should be allowed if claim 1 is allowed as claims 3 – 6 depend from claim 1.

Claim 8

In claim 8, Applicants recite a cover sheet for scanning a document. The cover sheet includes machine readable markings, one or more user selectable markings, and tactilely readable markings. The tactilely readable markings include a description of the one or more user-selectable features.

Claim 8 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. In order to sustain an obviousness rejection under 35 U.S.C. 103(a), the Examiner must show that a combination of the cited references teach or suggest all the limitations of the claim being rejected. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner has failed to show that the combination of references teaches or suggests all the limitations of claim 8. The Examiner has not established that Barker discloses a cover sheet including user selectable features, and tactilely readable markings where the tactilely readable markings include descriptions of the user-selectable features. The Examiner has not pointed to a portion of Yakata that provides this limitation either. The passage from Yakata cited by the Examiner appears to disclose a label with tactilely readable parameters, but the Examiner has not shown where either reference discloses a cover sheet including user selectable features, and tactilely readable markings where the tactilely readable markings include descriptions of the user-selectable features. Based upon the disclosure in Yakata, combining the disclosure of these two patents would not appear to anticipate all the limitations of

Applicants' claimed invention. Therefore, the Examiner has failed to show that the combination of patents discloses all the elements of claim 8. Because the Examiner has failed to prove that claim 8 is obvious in view of the combination of Barker and Yakata, claim 8 should be allowed.

Claims 11 – 14 should be allowed if claim 8 is allowed as claims 11 – 14 depend from claim 8.

Further, the Examiner asserts that it would have been obvious to combine the Yakata patent with the Barker patent because a blind person would need tactilely readable descriptions of the selectable parameters thereon. However, this is not an acceptable reason. Enabling visually impaired users to use scanned cover sheets is a purpose for Applicants' claimed invention and (ignoring the fact that the combination does not enable Applicants' invention) Applicants' own invention cannot be used against Applicants when determining obviousness. The Examiner must rely upon some reason explicitly or implicitly present in the prior art.

Conclusion

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

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A telephone interview is respectfully requested at the number listed below prior to any further Office Action, i.e., if the Examiner has any remaining questions or issues to address after this paper. The undersigned will be happy to discuss any further Examiner-proposed amendments as may be appropriate.

Respectfully submitted,

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